

Remarks

Status of the Application

Claims 1-15, 17-24, 27-28, 35, and 37-42 are pending with the entry of this amendment. Claims 1, 14, 21, 35 and 39 are amended. Claims 29-34 are canceled.

The Amendments

The amendments to the claims do not add new matter to the application as originally filed.

The Objections to the Drawings

The drawings are objected to under 37 CFR § 1.83(a), for purportedly not showing every feature of the invention specified in the claims. In particular, the objection pertains to claims 29-34. Although Applicants do not agree that the objection is proper, to expedite prosecution Applicants have canceled claims 29-34. The cancellation of such claims is without prejudice to their later renewal in this or a continuing application and is not to be construed as a disclaimer of the subject matter of those claims.

The 35 USC § 102 Rejections

Claims 1-4 and 12-15 and 17-18 stand rejected under 35 USC § 102(e) as allegedly being anticipated by Bevirt (US 6,063,579). Independent claim 1, as amended herein is directed to positioning devices that have an alignment member that is "in contact with an inner wall at an edge of a well area of the microtiter plate." The alignment structure of Bevirt contacts the microtiter plate between wells, and not at an inner wall at an edge of the well area of the microtiter plate. Since Bevirt does not describe each element of claim 1, this ground of rejection should be withdrawn for each of rejected claims 1-2 and 12-13.

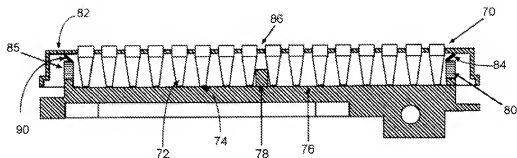


Fig. 5

Claim 14, as amended herein, is directed to a retaining device for retaining a microtiter plate in a desired position on a support, wherein the retaining device comprises a vacuum plate and a microtiter plate that is placed on the vacuum plate, wherein the vacuum plate comprises: a) a lip surface that is in contact with a bottom surface of an outer wall of the microtiter plate b) that is recessed relative to the lip surface and contacts an outer wall of a microtiter plate when the plate is placed in a desired position on the support, and c) a vacuum groove that is disposed between the lip surface and the interior surface. The interior surface is recessed relative to the lip surface. Outer walls of microtiter plates are shown, for example, as reference numeral **84** in Figures 5 and 6 and described in the specification at, for example, paragraph 00019: "Microtiter plates also generally have an inner wall **88** and an outer wall **85**, the outer wall generally defining the peripheral shape of the plate, and the inner wall generally defining a well area **92** on the plate."

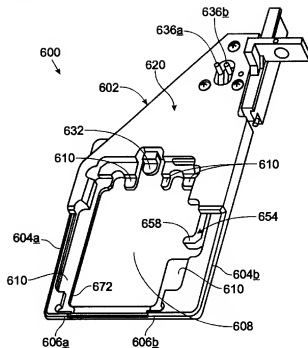
The device described in Bevirt does not have each of the elements discussed above. As shown in Figure 5 of Bevirt (reproduced above), no structure of the positioner is in contact with a bottom surface of the outer wall (which is a wall that defines the peripheral shape of the plate) of the microtiter plate. Nor does the Bevirt device have a vacuum groove that is disposed between the lip surface and the interior surface. Therefore, claim 14 as amended herein is not anticipated by Bevirt. Nor are claims 15, 17 or 18, each of which depends from claim 14.

The 35 USC § 103(a) Rejections

Claims 1-15, 17-24, 27-35 and 37-42 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Burton (WO 99/04228) or Modlin (US Patent No. 6,071,748) in view of Cathcart (US 5,443,791), Markin (US 5,417,922) and Bevirt. As the Burton and Modlin references have equivalent disclosures, and to be consistent with the Office Action, Applicants' remarks below refer to the Modlin patent. Applicants respectfully traverse these rejections.

Bervit, as discussed above, does not describe a positioning device in which an alignment member is in contact with an inner wall at an edge of a well area of a microtiter plate, as is required by independent claims 1, 21, 29 and 35 (as amended herein). Nor does either of Burton or Modlin describe such a device. In contrast, the positioners described in those two references have alignment members (shown in Fig. 22a-c of Modlin as 604a,b and 606a,b) that contact the outer edges of the microtiter plate. See, e.g., column 20, lines 14-15 ("In analyzer 50, long sides of the rectangular sample container are positioned against flanges 604a,b."). The positioning arms in the device described by Modlin also contact an outer wall of the microtiter plate, and act to push the outer walls of the plate that are opposite the positioning arms against the flanges (see, e.g., column 21, lines 25-30: "Biasing spring 642a pushes Y-axis positioning arm 622a toward cavity 608. Bumper 632 engages the sample container and pushes it away from body 602 until it abuts extensions 606a,b. Biasing spring 642b pushes X-axis positioning ann [sic, arm] 622b toward cavity 608. Edge 660 of second projection 658 engages the sample container and pushes it away from flange 604b until it abuts flange 604a.>"). Therefore, Modlin, Burton, and Bevirt all fail to describe any devices in which a positioner includes an alignment member that is in contact with an inner wall at an edge of a well area of a microtiter plate. Cathcart and Markin likewise do not describe any devices that meet this claim limitation. Since not all claim elements are described in the cited references, independent claims 1, 21, 29, and 35, as well as dependent claims 2-15, 17-20, 22-24, and 37-38 (all of which depend from claims 1, 21, 29 or 35), are not *prima facie* obvious over the cited references.

Fig. 22a



Claims 39-40 and 42 require that an alignment surface of an inner wall at an edge of a well area of a microtiter plate is placed adjacent with an alignment member. None of the cited references describe such a method, as they do not describe any device in which an alignment member is capable of being placed adjacent to an inner wall at an edge of a well area of a microtiter plate. Therefore, these claims are not *prima facie* obvious over the cited combination of references.

Claims 14, 15, 17-20, and 32-34 each recite, or depend from a claim that recites, that the device comprises a vacuum plate that comprises a microtiter plate and a) a lip surface that is in contact with a bottom surface of an outer wall of the microtiter plate; b) an interior surface that is recessed relative to the lip surface, and c) a vacuum groove disposed between the interior surface and the lip surface, wherein when a vacuum is applied, the vacuum plate holds the microtiter plate in the desired position. Neither Burton nor Modlin describe a device that has such a structure. The Bevirt, Markin and Cathcart references likewise fail to teach a device

having the claimed structure. Consequently, these claims are not *prima facie* obvious over the cited references.

Conclusion

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for examination. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned attorney at 858-812-1547.

Respectfully submitted,

/Timothy L. Smith, Reg. No. 35367 /

Timothy L. Smith, Ph.D.
Reg. No. 35,367

GENOMICS INSTITUTE OF THE NOVARTIS RESEARCH FOUNDATION
10675 John Jay Hopkins Drive, Suite E225
San Diego, CA 92121
Tel: (858) 812-1547
Fax: (858) 812-1981